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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,260	04/25/2000	David W. Cunningham		8995

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EXAMINER
PORTER, RACHEL L

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/558,260	CUNNINGHAM, DAVID W.
	Examiner	Art Unit
	Rachel L. Porter	3626

-- The MAILING DATE of this communication appears on the c ver sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 April 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed April 25, 2000. Claims 1-16 are pending.

2. The information disclosure statement filed June 23, 2000 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language (German Document No. DE431194A1). It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 3,7,8 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 2 recites the limitation "the same" in lines 2-3 of the claim. There is insufficient antecedent basis for this limitation in the claim. It is unclear from the current claim language which features/limitations are being addressed by the phrase “the same.” The Examiner suggests amending the claim language to repeat the limitations

that are being referred to with the phrase "the same" (e.g. "while *the cards* are in the possession of the prescriber," instead of "while the same are in the possession of the prescriber".)

A similar analysis may be applied to claims 7 and 15 regarding the use of the phrase "the same."

Claims 3 and 8 are dependent from claims 2 and 7 respectively. Claims 3 and 8 therefore inherit the deficiencies of their respective base claims through dependency and are also rejected.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-8 and 11-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 23-26 of U.S. Patent No. 5,832,449. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See,

e.g., *In re Berg*, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985)

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-4 and 5-8 of the present application are generic to the methods recited in claims 1-4 and 23-26, respectively, of U.S. Patent No. 5,832,449. That is, claims 1-4 and 23-26 of U.S. Patent No. 5,832,449 fall entirely within the scope of claims 1-4 and 5-8 of the present application, or in other words, claims are 1-4 and 5-8 of the present application are anticipated by claims 1-4 and 23-26 of U.S. Patent No. 5,832,449. Specifically, since "product trial cards" and "pharmaceutical trial products" are species of the generic categories defined by "product cards" and "pharmaceutical products," the process of claims 1-4 and 5-8 reciting "product cards" and "pharmaceutical products" are anticipated by claims 1-4 and claims 23-26 of U.S. Patent No. 5,832,449 reciting "product trial cards" and "pharmaceutical trial products."

Similarly, claims 11-15 of the present application and claim 23 are not patentably distinct from each other because claims 11-15 of the present application are generic to the methods recited in claim 23 of U.S. Patent No. 5,832,449. That is, claim 23of U.S. Patent No. 5,832,449 falls entirely within the scope of claims 11-15 of the present application, or in other words, claims 11-15 are anticipated by claims 23 and 23-26 of U.S. Patent No. 5,832,449. Specifically, since "product trial cards" and "one or pharmaceutical trial products" are species of the generic categories defined by "product cards" and "one or more pharmaceutical products," the process of claims 11-15 reciting

"product cards" and "one or more pharmaceutical products" are anticipated by claim 23 of U.S. Patent No. 5,832,449 reciting "product trial cards" and "pharmaceutical trial product."

Claim 16 is dependent from claim 11 and therefore inherits the deficiencies of claim 11 through dependency and is therefore also rejected.

8. Claims 9-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,055,507. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985) Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 9-10 of the present application are generic to the system recited in claims 1-2 of U.S. Patent No. 6,055,507. That is, claims 1-2 of U.S. Patent No. 6,055,507 fall entirely within the scope of claims 9-10 of the present application, or in other words, claims 9-10are anticipated by claims 1-2 of U.S. Patent No. 6,055,507. Specifically, since "product trial cards" and "pharmaceutical trial products" are species of the generic categories defined by "product cards" and "pharmaceutical products," the systems of claims 9-10 reciting "product cards" and "pharmaceutical products" are anticipated by claims 1-2 of U.S. Patent No. 6,055,507 claims "product trial cards" and "pharmaceutical trial products."

Claim Rejections - 35 USC § 103

9. Claims 1-8 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelson et al (US Patent No. 5,737,539—referred to herein after as Edelson) in view of Yoshino et al. (US Patent No. 4,827,112—referred to hereinafter as Yoshino).

As per claims 1-8 and 11-16 Edelson teaches an automated method for creating patient prescriptions based on health conditions and for providing the created prescriptions to pharmacies. (col. 53, lines 52-col. 54, lines 51) Edelson further teaches a method that uses a plurality of security and authentication measures to limit access to patient medical data to authorized users. These security measures include security control cards and passwords to ensure that only authorized individuals gain access to information. (col. 10, lines 66-col. 10, line 30) Edelson further discloses a method that provides "prescription fulfillment information" to pharmacies to ensure that prescriptions have not been filled multiple times, to avoid system abuse. (col. 27, line 55-col. 28, line 7) The fulfillment information is provided to the pharmacy using appropriate reporting media. Edelson does not specifically disclose that the reporting media, and the other control cards provided in the method, are presented by patients seeking medical services (i.e. getting prescriptions) at a pharmacy. Yoshino teaches a method/system wherein media encoded with prescription data (e.g. IC cards) are presented by patients receiving medical services at a pharmacy. (col. 6, line 63-col. 16) At the time of the Applicant's invention, it would have been obvious to combine the method of Edelson with the teaching of Yoshino to have the prescription data created in

the method of Edelson encoded on a medium (i.e. IC card) to be presented by the patient to have a prescription filled. One would have been motivated to do this reduce the risk of prescription abuse, as suggested by Edelson. (col. 27, lines 44-col. 54)

10. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edelson.

As per claims 9-10, Edelson teaches a system including a first array of computers located with prescribers and second array of terminals located with pharmacies (Figure 16, col. 44, line 8-col. 46, line 28). The system also includes a central facility with associated databases. Edelson further teaches a system that includes media encoded with information regarding a pharmaceutical to control the dispensing of the pharmaceutical. (col. 27, lines 55-28, line 7). Edelson does not specifically teach that the pharmaceutical media assume the form of individual media slips, but does teach that the system accommodates a plurality of media forms. (col. 52, line 49-col. 53, line 14) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to include individual media slips among the types of media accommodated by the system. One would have been motivated to do this to make the system more marketable, by maximizing its flexibility and compatibility with a number of legacy systems.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ballantyne et al (US Patent No. 5,867,821) teach the use of smart card technology to store and retrieve patient data.
- Albaum et al (US Patent No. 5,758,095) teaches an automated prescription/ drug dispensing system.
- Welner (US Patent No. 5,612,870) teaches a system including a plurality of authorization levels to access patient data.
- Ballet et al (WO 9303457 A1) teaches a multi-card authorization system for accessing patient data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is 703-305-0108. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703)305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-7687 for regular communications and (703)305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

RP
December 16, 2002

DINH X. NGUYEN
PRIMARY EXAMINER